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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/757,703	01/15/2004	Francois Lacoste	91301	4489
24628 7590 11/25/2008 Husch Blackwell Sanders, LLP Husch Blackwell Sanders LLP Welsh & Katz 120 S RIVERSIDE PLAZA 22ND FLOOR CHICAGO, IL 60606				
EXAMINER ROZANSKI, MICHAEL T				
ART UNIT		PAPER NUMBER		
3768				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/757,703

**Applicant(s)**

LACOSTE ET AL.

**Examiner**

MICHAEL ROZANSKI

**Art Unit**

3768

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 September 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3, 5, 8 and 12-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5, 8 and 12-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Objections***

Claims 1-3, 8, 13-15, and 24 are objected to because of the following informalities: These claims a device with limitations of "having" or "further having." In these instances, "having" should be changed to "comprising" in order to properly distinguish the preamble from the body. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 15-24 are rejected under 35 U.S.C. 102(e) as being anticipated by Chopra et al (previously cited).

Chopra et al disclose a method and apparatus for ultrasound therapy including a transducer, preferably planar, enabling operation at a range of frequencies for optimal control of the depth of thermal coagulation (col 3, lines 13-17). The applicator housing 2 and the acoustic window 1 are depicted in Figure 4. The acoustic window is not considered to be a membrane of the transducer (as claimed in claim 15) and there is

otherwise no membrane disclosed that would be considered a membrane. Therefore, the transducer is considered to be a transducer without a membrane. The planar transducer is mounted in the region of an end of flexible cables 5, which are used to power the transducer (col 8, lines 58-62). Chopra et al discloses a cooling and coupling fluid circuit with fluid inlet 10 and outlet openings 11 (see Figure 4). It is noted that the language regarding the cable and transducer "adapted to pass in an operating channel of an endoscopic apparatus" in claims 15 and 19 does not define sufficient structure to define over Chopra et al, because the Chopra et al apparatus is capable of being inserted into an endoscopic channel, even though that may not be the intended purpose. In addition, the claim language in claim 24 regarding a "laparoscopy probe" is not given much patentable weight because the body of the claim does not feature any elements of a laparoscope. Rather, the body only features the elements associated with the coagulating 'beam-type' transducer. It is noted that Examiner has reviewed the Applicant arguments of 2/5/08 in response to an Office Action that used Chopra et al. Under the current claim language and the above description, the arguments are unpersuasive.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 5, 8, and 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chopra et al in view of Parins et al (US 6,293,945).

Chopra et al disclose a 'beam-type' ultrasound coagulating planar transducer as described above. Chopra et al do not disclose a channel in the region of the transducer adapted to transmit a vacuum for keeping the laparoscopy probe in place on an organ. Parins et al teach of the vibrating-type coagulating device that is used in laparoscopic procedures, wherein coagulation is not caused by the ultrasonic beam. Parins et al also teach of a lumen 33 used as a suction path for a vacuum (col 2, lines 61-65). The operator may apply different levels of suction by covering/uncovering aperture 55 with a finger (col 3, lines 9-17). The stated function of the vacuum is to remove debris from the area adjacent to the end of the tube (col 3, lines 15-17). It is noted that whether the stated purpose for a vacuum is to remove debris as in Parins et al or to keep a probe in place on an organ as in the present application there is not a resulting structural difference. The vacuum of Parins et al is also considered to keep a probe in place during a laparoscopic procedure, as the current claim does not feature any limitations that would permit the vacuum to keep the probe while not permitting the vacuum of Parins et al to do the same. Furthermore, it is not important that Parins et al does not utilize the beam-type coagulation. The references are related in that they are each used for coagulation of tissue where debris may be present. It would have been obvious to modify Chopra et al, to include a vacuum as taught by Parins et al, because such is useful in coagulating/laparoscopic procedures to remove debris and/or keep the probe in place against an organ.

In regard to claim 13, Parins et al teach a blade 20 used for cutting tissue, which is commonly associated with the coagulation of tissue. The blade 20 that is movable in directions 15 by thumb slide 25 (col 2, lines 40-49). There are multiple configurations with which the blade can be moved (see Figures 4-8). Examiner is proposing to incorporate the retractable blade feature and, therefore, it is not important that Parins et al do use vibration-type coagulation, instead of beam-type. Nevertheless, the references are related due to the coagulation feature. It would have been obvious to modify Chopra et al, to include a retractable blade as taught by Parins et al, in order to have both cutting and coagulating functions, as common to similar devices.

The statement given above regarding the laparoscopy probe applies here as well.

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-3, 5, 8, and 12-24 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL ROZANSKI whose telephone number is (571)272-1648. The examiner can normally be reached on Monday - Friday, 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Casler can be reached on 571-272-4956. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Eric F Winakur/  
Primary Examiner, Art Unit 3768

MR